



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,391	07/01/2003	Susan Hickey	100041-41143	1534

7590 08/17/2004

Mark P. Levy, Esq.
Thompson Hine LLP
2000 Courthouse Plaza NE
10 W. Second Street
Dayton, OH 45402-1758

EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
----------	--------------

3611

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,391

Applicant(s)

HICKEY ET AL.

Examiner

Brian K. Green

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the binding means defined in claim 8, the backing pad defined in claims 14 and 21, and the anti-static coating defined in claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: The specification fails to define a backing panel as claimed in claims 14 and 21. The specification fails to define what the numeral (18) shown in the figures represents.

Appropriate correction is required.

Claim Objections

Claims 1-31 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In claims 1-31, "mousepad" should apparently be "mouse pad". In claim 11, line 2, "thoron" should apparently be "thereon".

Claim Rejections - 35 USC § 112

Claims 2,9,15,17,27,30, and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The applicant fails to define what materials are used to reduce the static electricity charge and would enable the surface resistivity of each sheet to be between 800 and 3000 ohms.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3611

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8,10-15,17-26, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (U.S. Patent No. 5,876,010) in view of Yawman (U.S. Patent No. 1,034,670).

Murphy shows in figures 1-4 a mouse pad (10) that includes a plurality of stacked sheets (14) wherein each adjacent sheet is joined to another adjacent sheet along at least two separate edges. Murphy does not disclose placing a calendar portion on each of the sheets. Yawman shows in figure 1 the idea of placing a calendar portion (Sunday April 25, 1909 on the top sheet, and different dates on the rest of the sheets) on each of the removable sheets (1). In view of the teachings of Yawman it would have been obvious to one in the art to modify Murphy by placing a calendar portion on each of the sheets since this would the days date to be indicated which would make the pad more useful. In regard to claims 2,15, and 17, the sheets of Murphy are made out of paper which is considered to have a reduced static electricity charge of less than 100 volts. The applicant fails to specify what the static electricity is "reduced" with respect to. Paper is not capable of holding a charge of 100 volts and further the paper of Murphy would be grounded at certain times (a persons hand resting on the pad, the pad resting on a metal surface, etc.), would have little or no charge when not used for an extended period of time. In regard to claims 3,4, and 6, the sheets are generally rectangular with rounded corners and are adhered together with adhesive along two side edges, see column 2, lines 45-51 and column 3, lines 40-45. In regard to claims 5 and 11, Yawman discloses the idea of placing different calendar portions on each sheet, i.e. each calendar sheet includes a different date. In regard to claim 7, the

Art Unit: 3611

adhesive used is inherently weaker than the sheets since this sheets are separated from one another without damaging the sheets, see figure 2. In regard to claim 8, as broadly defined, the adhesive is considered to be the binding means. In regard to claim 10, the sheets of Murphy are generally aligned. In regard to claim 12, Yawman shows a "month" (April). In regard to claims 14 and 21, Murphy shows a pad (20). In regard to claim 23, Yawman discloses the idea of placing the sheets in chronological order, i.e. the dates of the year. In regard to claim 26, the sheets of Murphy are removed in a tear off manner. In regard to claim 28, the steps defined are the conventional steps that are followed in using a mouse pad, i.e. locating a computer mouse onto the mouse pad, moving said mouse along the pad to cause movement of a cursor on a computer display. In regard to claim 29, Murphy teaches the idea of removing a top sheet to expose another sheet. In regard to claim 30, this is the conventional manner in which the mouse pad is formed. In regard to claim 31, the sheets of Murphy are made out of paper which is considered to have a reduced static electricity charge of less than 100 volts. Paper is not capable of holding a charge of 100 volts and further the paper of Murphy would be grounded at certain times (a persons hand resting on the pad, the pad resting on a metal surface, etc.) and would therefore have a zero voltage.

Claims 9,16, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (U.S. Patent No. 5,876,010) in view of Yawman (U.S. Patent No. 1,034,670) as applied to claims 1 and 15 above and further in view of Scianna (U.S. Patent No. 5,997,995).

In regard to claims 9 and 27, Murphy in view of Yawman disclose the applicant's basic inventive concept except for making the resistivity of each sheet between 800 and about 3000

Art Unit: 3611

ohms. Murphy fails to disclose the resistivity of the sheets but does disclose that the sheets are made from paper. Paper inherently has a high resistivity since it is an insulator. Paper would have a resistivity higher than the range specified by the applicant. Scianna discloses in column 3, lines 1-6 the idea of adding a dielectric material to a mouse pad in order to reduce static electricity. In view of the teachings of Scianna it would have been obvious to one in the art to modify Murphy by making adding a dielectric material to each sheet since this would reduce the amount of static electricity stored on the sheets and would provide a resistivity of between about 800 and about 3000 ohms. The addition of the dielectric material to each of the sheets of Murphy would reduce the resistivity of each of the sheets of Murphy and make the resistivity in the neighborhood of that specified in the claims. In regard to claim 16, Murphy in view of Yawman disclose the applicant's basic inventive concept except for adding an anti-static coating to each sheet. Scianna discloses adding an anti-static coating to a mouse pad, see column 3, lines 106. In view of the teachings of Scianna it would have been obvious to one in the art to modify Murphy by attaching an anti-static coating to the sheet since this would help to reduce the amount of static electricity stored by each sheet.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy (U.S. Patent No. 5,876,010) in view of Yawman (U.S. Patent No. 1,034,670) as applied to claim 15 above and further in view of Kuipers (U.S. Patent No. 5,217,781).

Murphy in view of Yawman disclose the applicant's basic inventive concept except for adding an anti-static coating to each sheet. Kuiper discloses in column 1, lines 25-30 the idea of adding an anti-static coating to a mouse pad. In view of the teachings of Kuiper it would have

Art Unit: 3611

been obvious to one in the art to modify Murphy by attaching an anti-static coating to the sheet since this would help to reduce the amount of static electricity stored by each sheet.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

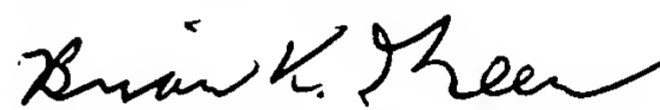
Lee, Pearson, Slagsvol, and Smirnoff teach the use of a plurality of sheets attached to one another. Rzepecki et al. and WO 94/20289 teach the use of devices that help to dissipate static electricity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Aug. 11, 2004